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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,251	11/08/2001	Lee Delson Wilhelm	13929.1	5614

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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/010,251

Applicant(s)

WILHELM, LEE DELSON

Examiner

Mark Halpern

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-13,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

- 1) Acknowledgement is made of Appeal Brief received 4/14/2003, Paper No. 10.
- 2) The finality of rejection issued in Office Action of 10/16/2002, is withdrawn in view of the arguments presented in the Appeal Brief, and upon reconsideration of art in the prior art.
- 3) Claim 22 rejection under 35 U.S.C. 112, first paragraph, is withdrawn in view of the arguments presented in the Appeal Brief.
- 4) Claims 8-9, 12-13, 21-22, rejection under 35 U.S.C. 103(a) as being unpatentable over Schulz (5,620,776), is withdrawn in view of the arguments presented in the Appeal Brief.
- 5) Claims 10-11, rejection under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Rheingold (3,563,819), is withdrawn in view of the arguments presented in the Appeal Brief.

### ***Specification***

- 6) Cross-reference section should be updated to indicate that application 09/283,502, is now Patent U.S. 6,344,111.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7) Claims 8-10, 12, 21-22, are rejected under 35 U.S.C. 102(b) as being anticipated by Cleveland (2,114,072).

Claims 8, 21: claim recites that an embossing roll will cause a percentage of fiber-to-fiber bonds broken in a center 0.02 mm thickness of a paper sheet to be less than a percentage of the fiber-to-fiber bonds broken within 0.02 mm of a paper surface of the same sheet, wherein said protuberances or depressions are sized at less than about 0.1 mm. In order to induce this paper property the surface of the present roll is structurally defined in the present Specification having protrusions of height of about 0.005 in. to about 0.04 in., and width from about 0.005 to about 0.50 in. (as recited on page 21, lines 3-15), and protrusions from about 0.004 in. to about 0.002 in., and width dimension of about 0.003 in. to about 0.001 in. (as recited on page 22, lines 7-17). Cleveland discloses a roll for papermaking having indentions of depth from about 0.002 in. to 0.02 in., and diameter from about 0.005 in. to 0.04 in. (Cleveland, pg. 2, col. 2, lines 23-30). Cleveland discloses the dimensions that are in the same range as in present disclosure which causes the claimed effect on paper and thus, Cleveland anticipates the claimed invention.

Claims 9, 12: claims recite that the structure of the roll surface is such that surface deformations in the paper are visible and invisible to the unaided human eye. Cleveland discloses the dimensions that are in the same range as in present disclosure

which causes the claimed effect on paper and thus, Cleveland anticipates the claimed invention.

Claim 10: the surface of the Cleveland roll is etched or sand blasted to obtain indentions (pg. 1, col. 2, lines 37-47).

Claim 22: claim recites that the roll height of embossing elements not used to form visually distinctive icons is less than one-half a thickness of a paper sheet to be embossed, wherein protuberances or depressions are sized at less than about 0.1 mm. Cleveland discloses the dimensions that are in the same range as in present disclosure which causes the claimed effect on paper and thus, Cleveland anticipates the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 11, 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleveland in view of Johnson (2,498,275).

Claim 11: Cleveland is applied as above for claim 8, Cleveland fails to disclose method of making depressions by stippling. Johnson discloses method of making depressions by stippling in a surface of a product (col. 9, lines 20-30 and Figures 25, 32). It would have been obvious, to one skilled in the art at the time the invention was

made, to combine the teachings of Johnson and Cleveland, because such a combination would provide a means of creating delicate depressions in the roll of Cleveland.

Claim 13: claim recites that the structure of the roll surface is such that surface deformations in the paper are visible and invisible to the unaided human eye. Cleveland discloses the dimensions that are in the same range as in present disclosure and which causes the claimed effect on paper thus, Cleveland disclosure reads on the claimed invention.

### ***Conclusion***

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

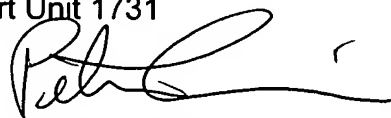
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone no. is 703-308-0651.

June 29, 2003

MH

Mark Halpern  
Patent Examiner  
Art Unit 1731



PETER CHIN  
PRIMARY EXAMINER